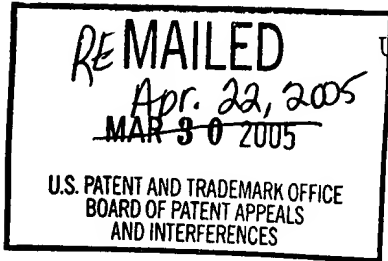


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LEO K. VAN ROMUNDE and PAUL CLAUDE KAISER

Appeal No. 2004-1825
Application 09/402,563

ON BRIEF

Before JERRY SMITH, OWENS and MacDONALD, *Administrative Patent Judges.*

OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-3, 5-14, 16 and 17, which are all of the pending claims.

THE INVENTION

The appellants claim a method and system for electronically storing, retrieving and/or modifying records. Claims 1, 2 and 11, which claim the method, are illustrative:

1. Method for electronically storing, retrieving and/or modifying records using a computer system comprising a display unit, an input unit, a memory unit and a processing unit, and involving at least one recorded catalogue of recommended actions, and for sequentially steering a process of interrelated actions from said at least one recorded catalogue of recommended actions, wherein said at least one recorded catalogue of recommended actions comprises hierarchised sequences of alternative actions, wherein said actions comprise sequential procedure steps and wherein for each of said steps the method generates electronic evaluation forms hierarchically organized as forms and subforms, wherein said evaluation forms comprise a list of recommended actions, information-input requests and/or decision-requests, and wherein said generation of evaluation forms is carried out in function of said hierarchised sequences of alternative actions of said catalogue of recommended actions, and in function of the past history of actions so as to enable transfer of a group of evaluation forms and subforms in one operation into one file.

2. Method according to claim 1, wherein said at least one recorded catalogue of recommended actions comprises associated electronic selection algorithms in respect of the hierarchised sequences of alternative actions.

11. Method according to claim 1, wherein the steering software is an application embodiment of commercial LOTUS NOTES and/or LOTUS DOMINO NOTES software.

THE REFERENCE

McIlroy et al. (McIlroy)

5,583,758

Dec. 10, 1996

THE REJECTION

Claims 1-3, 5-14, 16 and 17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McIlroy.¹

OPINION

The aforementioned rejection is affirmed as to claims 1-3, 5-10, 12-14, 16 and 17, and is reversed as to claim 11. Under the provisions of 37 CFR § 41.50(b) we enter a new ground of rejection of claim 11.

The appellants state that the claims stand or fall in three groups: 1) claims 1, 5-10, 12, 16 and 17; 2) claims 2, 3, 13 and 14, and 3) claim 11 (brief, pages 3-4). We therefore limit our discussion to claim 11 and one claim in each of the other groups, i.e., claims 1 and 2. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192©) (7) (1997).

¹ In the examiner's answer the examiner includes only claims 1, 2 and 11 in the statement of the rejection (page 3). The examiner's reference to the other claims within each group (answer, pages 5 and 10) indicates that the rejection applies to all of the claims.

Claim 1

McIlroy discloses a computer hardware and software implemented health care management data processing system (col. 1, lines 27-35; col. 4, lines 51-60).

The appellants argue that McIlroy does not disclose at least one recorded catalogue of recommended actions (brief, pages 5-8). The appellants argue that McIlroy's only catalogue of recommended actions is that shown in figures 7, 15 and 16, and that the catalogue is merely displayed, not recorded (brief, page 8). During patent prosecution, claims are to be given their broadest reasonable interpretation consistent with the specification, as the claim language would have been read by one of ordinary skill in the art in view of the specification and prior art. See *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). We do not find in the appellants' specification any limitation of the meaning of "recorded catalogue". Hence, we interpret that term as including McIlroy's catalogues of recommended actions in figures 7 and 15 and 16 that are generated from the recorded catalogue of treatments in figures 8a and 8b (col. 7, lines 26-29).

The appellants argue that there is no hierarchy in the list of alternative treatment options in McIlroy's figure 7 (brief, pages 8-9). The hierarchy is shown in McIlroy's figures 15 and 16, wherein treatments 2A and 2B are recommended. The appellants argue that there is no teaching that recommended treatments always appear at the top of McIlroy's list of alternative treatments (brief, page 9). Such a teaching is not required for anticipation of the appellants' claimed invention. The disclosure of a hierarchy of alternative treatments in figures 15 and 16 is sufficient for that purpose.

The appellants argue that McIlroy does not disclose subforms (brief, page 10). The appellants argue that a subform is a form that can be embedded within a main form and will behave and appear to the end user as if it were an integral part of the form, and that when a subform is changed all of the form containing that subform automatically reflects the change. See *id.* The appellants' specification discloses that "[a] subform comprises a portion of the form" (page 6, lines 11-12). Hence, the specification does not indicate that "subform" in claim 1 is to be given the narrow interpretation argued by the appellants. See *Zletz*, 893 F.2d at 321, 13 USPQ2d at 1322; *Sneed*, 710 F.2d at 1548, 218 USPQ at 388. The appellants argue

that McIlroy's forms that are obtained by clicking on a button in another form are not subforms (brief, pages 10-11). As indicated by the appellants' figure 1, the appellants' subforms appear to include screens that are generated from another screen. Thus, we are not convinced that the appellants' term "subform" excludes McIlroy's screens such as the screens in figures 11-16 that are generated from the screen in figure 10, or the "Specialist Review" screen in figure 15 which is generated from a screen that lacks the "Specialist Review" screen (col. 16, lines 21-32).

The appellants argue that McIlroy does not generate evaluation forms for each sequential step of the hierarchized alternative actions (brief, page 11). The appellants' claim 1 does not require that evaluation forms and subforms are generated in each step but, rather, requires that evaluation forms and subforms are generated for each step. McIlroy's hierarchies of forms and subforms in figures 10-16 are generated for the sequential steps of the hierarchized alternative actions in figures 15 and 16.

The appellants argue that McIlroy's only sequences of alternative actions are the treatment options in figure 15, and that no forms are generated as a function of the treatment options (brief, page 12). The appellants' claim 1 requires that the generation of evaluation forms is carried out in function of the hierarchized sequences of alternative actions in the catalogue of recommended actions. We do not find in the appellants' specification any disclosure that limits the meaning of "in function of". The relevant dictionary definition of "function" is "[s]omething closely related to another thing and dependent on it for its existence, value, or significance".² McIlroy's generation of the forms in figures 10-16 is closely related to the hierarchized sequences of alternative actions produced using the forms, as shown in figures 15 and 16, and the form generation is dependent for its significance upon the hierarchized sequences of alternative actions that are generated. Hence, McIlroy's generation of forms is carried out in function of the hierarchized sequences of alternative actions.

² Webster's II New Riverside University Dictionary 512 (Riverside 1984). Copies of the dictionary definitions cited herein are provided to the appellants with this decision.

The appellants argue that McIlroy does not disclose generating evaluation forms in function of the past history of actions (brief, page 12). The appellants argue that the question component in McIlroy's figure 6 is not actions. See *id.* In that figure, however, past history is taken into account ("severe dyspnea even after treatment with inhaled meds"). The forms in figures 15 and 16 showing recommended treatments are generated in function of the past history referred to in figure 6.

The appellants argue that McIlroy does not disclose that the forms in figures 10-16 could be transferred into one file in one operation (brief, page 13). The appellants' specification does not define "operation". The relevant dictionary definition of "operation" is "[a]n action resulting from a single computer instruction."³ The appellants' claim 1 does not require a step of transferring a group of evaluation forms and subforms in one operation into one file but, rather, merely requires that such transfer is enabled. McIlroy's disclosures that 1) the system preferably is implemented on an IBM compatible personal computer using the Microsoft C language, 2) all patient information is to be in a single file, and 3) information can be added to an existing file (col. 4, line 50 - col. 5, line 2; col. 11,

³ See Webster's II, *supra* note 2 at 824.

lines 61-65), indicates that the system enables transferring at least two forms into a single file using a single instruction.

For the above reasons we are not convinced of reversible error in the examiner's rejection of claim 1. Accordingly, we affirm the rejection of that claim and claims 5-10, 12, 16 and 17 that stand or fall therewith.

Claim 2

The appellants argue that "[t]here is nothing in McIlroy et al. that teaches or suggests that the list of recommended actions shown in Fig. 7 comprise associated algorithms in respect of hierarchised sequences of alternative actions" (brief, page 14). McIlroy necessarily must have an algorithm for selecting the treatments in figures 15 and 16 from the menu in figure 8, and for specifying the recommended treatments and placing them at the beginning of the lists in figures 15 and 16. Consequently, we affirm the rejection of claim 2 and claims 3, 13 and 14 that stand or fall therewith.

Claim 11

The examiner argues that McIlroy inherently discloses Lotus Notes® and/or Lotus Domino Notes® (answer, page 5). When an examiner relies upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably

support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int. 1990). The examiner, however, has not provided that basis in fact and/or technical reasoning.

The examiner argues that McIlroy discloses application software (col. 5, lines 42-45), and that specifying Lotus Notes® or Lotus Domino Notes® as the software provides no patentable weight to the claim (answer, pages 11-12). "Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference." *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255-56, 9 USPQ2d 1962, 1965 (Fed. Cir. 1989). The appellants' claim 11 limits the steering software to Lotus Notes® and/or Lotus Domino Notes®. The examiner has not explained how McIlroy discloses that limitation either expressly or under the principles of inherency.

We therefore find that the examiner has not carried the burden of establishing a *prima facie* case of anticipation of the method claimed in the appellants' claim 11. Accordingly we reverse the rejection of that claim.

New ground of rejection

Under the provisions of 37 CFR § 41.50(b) we enter the following new ground of rejection.

Claim 11 is rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the appellants regard as their invention.

Claim 11 does not specify the versions or dates of the Lotus Notes® and Lotus Domino Notes®. Hence, the claim encompasses any software that has been or will be created and given those names. The scope of the claim, therefore, is unclear.

DECISION

The rejection of claims 1-3, 5-14, 16 and 17 under 35 U.S.C. § 102(b) over McIlroy is affirmed as to claims 1-3, 5-10, 12-14, 16 and 17, and is reversed as to claim 11. A new ground of rejection of claim 11 has been entered under 37 CFR § 41.50(b).

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before

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Maria Parrish Tungol
1800 Diagonal Road
Suite 600
Alexandria, VA 22314-2840